

Appl. No. 10/601,042
Response dated May 9, 2005
Reply to Office Action of Feb. 7, 2005

Amendments to the Drawings:

The attached sheet of drawings includes changes to FIG. 1. This sheet, which includes FIGS. 1-2, replaces the original sheet including FIGS. 1-2. In FIG. 1, the reference number "600" has been replaced with the reference number "100".

Attachment: Replacement Sheet
Annotated Sheet Showing Changes

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration of this application. Claims 1-20 remain in the application. Of these, claims 1-5, 7, 8, 10, 11, 15, 17, 18 and 20 stand rejected, and claims 6, 9, 12-14, 16 and 19 stand objected to.

1. Objection to the Drawings

The Examiner objects to FIG. 1 in that the reference number "600" should apparently be "100". Applicants agree, and the attached sheet of drawings reflects this change.

The Examiner objects to FIGS. 2, 4 and 5 in that the reference number "204" is not described in the specification. Applicants agree, and have amended paragraph [0013] to insert a reference to, and description of, the feature identified by reference number "204". The amendment to paragraph [0013] comprises language taken from paragraph [0028] of the patent application of John F. Casey, et al. entitled "Methods for Making Microwave Circuits", which was 1) filed on the same date as this application and assigned Appl. No. 10/600,143, and 2) incorporated by reference in this application. Applicants also note that the subject matter claimed in this application was discussed to some degree in paragraphs [0046]-[0050] of Appl. No. 10/600,143. As a result of the above facts, applicants believe their amendments to paragraph [0013] do not add new matter.

2. Rejection of Claims 3, 5, 7, 8, 10, 11, 15, 17 and 18 Under 35 USC 112, Second Paragraph

Claims 3, 5, 7, 8, 10, 11, 15, 17 and 18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly

claim the subject matter which applicants regard as their invention. Specifically, the Examiner asserts that these claims are indefinite because:

5. Claim 3 contains the trademark/trade name DU PONT QG150.
...
6. Claims 5, 8, 11, and 15 contain the trademark/trade name KQ CL-90-7858.
...
7. Claims 7-8, 10, and 17 contain the trademark/trade name KQ.

2/7/2005 Office Action, pp. 3-4.

The Examiner cites *Ex parte Simpson* and states that, "the claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product."

Pursuant to M.P.E.P. § 608.01(v):

Names used in trade are permissible in patent applications if: (A) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or (B) In this country, their meanings are well-known and satisfactorily defined in the literature. See M.P.E.P. § 608.01(v) (8th Ed. Rev. 2003).

Applicants assert that the marks "DU PONT QG150", "KQ CL-90-7858" and "KQ" meet at least the second of the above requirements. As published on Heraeus Cermalloy's website, and in published papers, KQ dielectrics are glass dielectrics having a very low loss tangent (around 10-4) and dielectric constant (around 3.9). Defining a dielectric as a KQ CL-90-7858 dielectric, or defining a conductor as a DU PONT QG150 conductor, is even more definite, as KQ CL-90-7858 and DU PONT QG150 are not merely trademarks or trade names, but rather identifiers of specific products having specific compositions. Each of these marks is not merely a trademark or trade name, but rather an identifier of a specific product having a specific composition.

In the case of *Ex parte Simpson*, 218 USPQ 1020 (1982), which the Examiner relies on, the court upheld the Examiner's claim rejections pursuant to 35 U.S.C. 112,

second paragraph, where the claims contained the indefinite trademark "Hypalon." In that case the court stated:

"The claim scope is uncertain as regards the material which forms the "Hypalon" membrane. On the one hand, the claim language may be very narrowly construed to a particular chlorosulphonated ethylene having a specific group of additives employed by the owner of the "Hypalon" trademark to produce the desired properties, or on the other hand the claim language might be asserted by appellants, as it was in the unentered amendment filed July 27, 1978, to broadly encompass every *synthetic resin*."

The *Ex Parte Simpson* case was a rather unique case involving vague claim language which was made even more confusing by 1) applicants' use of Hypalon as a noun, and 2) applicants' attempt to argue that Hypalon encompassed a broader range of materials than indicated by Hypalon's manufacturer. Conversely, applicants' claims use the product identifiers "KQ", "DU PONT QG150" and "KQ CL-90-7858" in a proper manner; applicants have not argued for inconsistent interpretations of these terms; and it is clear what material is encompassed by each of these terms.

The unique nature of the *Ex Parte Simpson* case is readily apparent after reviewing *Ex Parte Jerry Kitten*, WL 33134953 (1999, unpublished opinion), wherein the Board of Patent Appeals declined to follow its holding in *Ex Parte Simpson*, reversing the Examiner's rejections and finding that the use of trademarks did *not* render claims unclear or confusing. *Ex Parte Jerry Kitten* found:

[b]ased on these product sheets and because claim 13 further limits the fertilizer used in claim 1 to a fertilizer prepared from these well-identified proprietary products, we do not find the use of the trademarks renders claim 13 unclear or confusing. Compare, *Ex Parte Simpson*, 218 USPQ 1020-23 (Pat. & Tdmk. Off. Bd. App. 1982). *Ex Parte Jerry Kitten*, 1999 WL 33134953 (Bd. Pat. App. & Interf.)

Similarly, applicants' claims 3, 5, 7, 8, 10, 11, 15, 17 and 18 further limit their claim 1. Applying the above reasoning to applicants' claims 3, 5, 7, 8, 10, 11, 15, 17 and 18, if claim 1 is definite and allowable (which the Examiner has indicated it is, but

for a double-patenting rejection which is overcome by the enclosed Terminal Disclaimer), then applicants fail to see how a claim which depends from a definite claim 1, and further limits claim 1, can be indefinite. Applicants believe this is the dilemma that the Board was faced with in *Ex Parte Jerry Kitten* and it explains why the Board reached different decisions in *Ex Parte Simpson* and *Ex Parte Jerry Kitten*.

Applicants acknowledge that *Ex Parte Jerry Kitten* is an unpublished and non-precedential opinion. However, given that there is relatively little case law in this area, and the facts of *Ex Parte Simpson* are not directly on point, applicants believe the Board would be likely to follow its reasoning in *Ex Parte Jerry Kitten* if this case were appealed.

In light of the above arguments, applicants believe their claims 3, 5, 7, 8, 10, 11, 15, 17 and 18 are sufficiently definite and should be allowed.

3. Nonstatutory Double-Patenting Rejection of Claims 1, 2, 4 and 20

Claims 1, 2, 4 and 20 stand provisionally rejected based on the judicially created doctrine of double-patenting.

Claims 1, 2 and 4 stand provisionally rejected over the claims of Casey et al. (U.S. Patent Appl. Pub. No. 2004/0257194) in view of Nguyen (U.S. Pat. No. 4,808,274). Claim 20 stands provisionally rejected over the claims of Casey et al. (U.S. Patent Appl. Pub. No. 2004/0257194) in view of Nguyen (U.S. Pat. No. 4,808,274) and Wolf et al. (Silicon Processing for the VLSI Era, Vol. 1, Lattice Press (1986)).

Given that the application on which the patent publication of Casey et al. (U.S. Patent Appl. Pub. No. 2004/0257194) is based has been allowed, Applicants submit herewith an appropriate Terminal Disclaimer. The Examiner's double-patenting rejections should therefore be withdrawn.

4. Allowability of Claims 6, 9 and 12

Applicants thank the Examiner for indicating the allowability of claims 6, 9 and 12, but for their dependence on other rejected claims. However, pending the Examiner's consideration of the above amendments and remarks, Applicants choose to leave these claims in their current form.

5. Conclusion

Given the above amendments and remarks, Applicants respectfully request the timely issuance of a Notice of Allowance.

Respectfully submitted,
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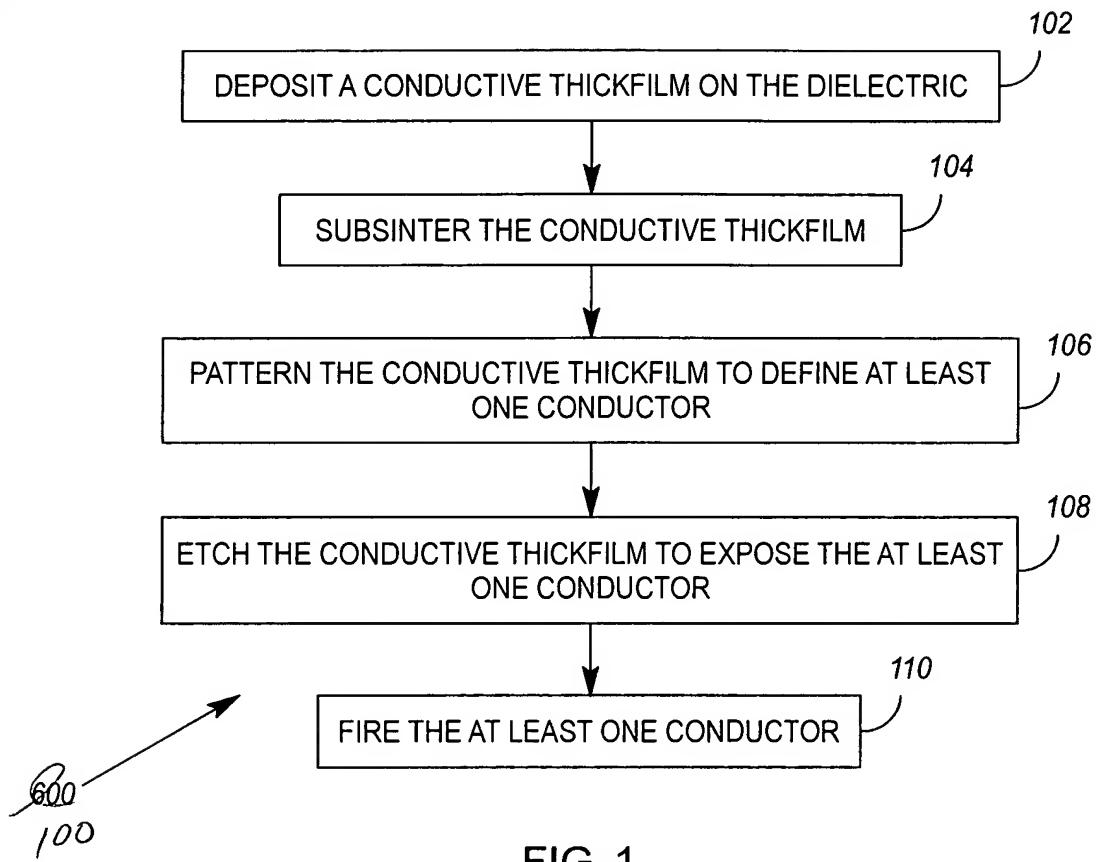


FIG. 1

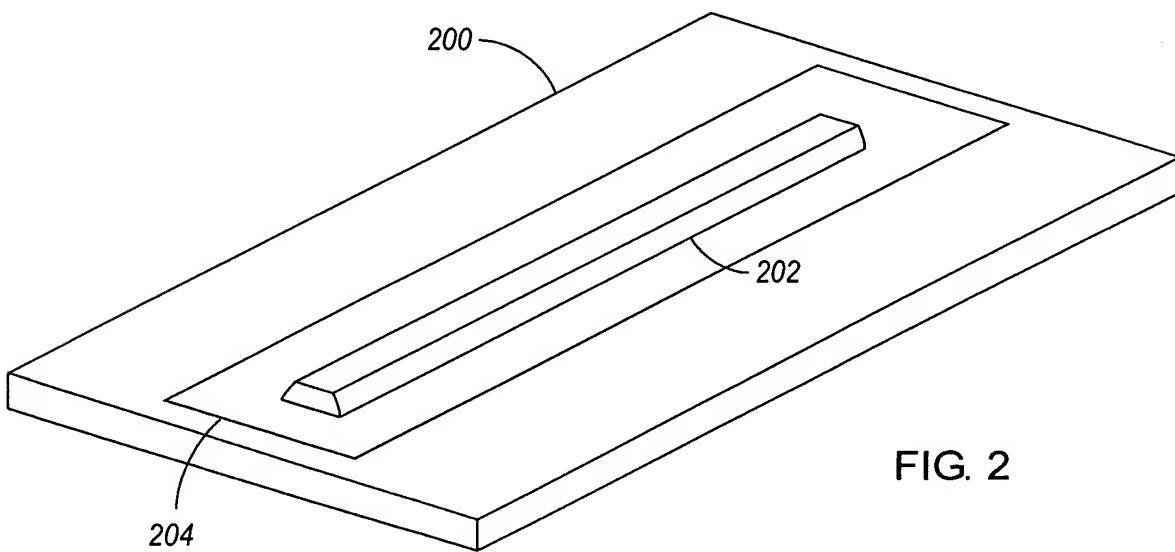


FIG. 2